

REMARKS

Claims 1-21 are currently pending in the instant application. The Examiner has withdrawn Claims 6-21 as being drawn to non-elected subject matter. Claims 1-3 have been amended. Support for this amendment can be found through the application, including page 19 and the compounds disclosed in the experimental section. Applicants assert that no new matter is being added by this amendment. Applicants reserve the right to file continuation applications to any subject matter not currently being pursued.

Restriction Requirement

The Examiner has required a restriction of the claimed invention under 35 U.S.C. 121 from the following groups:

1. Claims 1-5, drawn the compound of the formula I; or
2. Claims 6-21, drawn to pharmaceutical compositions and method of treating.

Applicants respectfully traverse the restriction. Section 803 of the M.P.E.P. states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Additionally, Section 803 provides:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is required.

Applicants assert that the groups recited by the Examiner are closely related since they cover either the compounds of Formula I or the compositions and use of such compounds. Because there would be no serious burden on the Examiner in searching such closely related groups, Applicants respectfully contend that any restriction requirement would be improper. Applicants expressly note that Applicants are not arguing that the group elected by Applicants is not patentably distinct, but rather, contend that the Examiner should examine all of the groups of the instant invention since there would be no serious burden on the Examiner. For the reasons noted above, Applicants respectfully request that the restriction requirement be withdrawn.

However, in order to facilitate the Examiner's search under 37 C.F.R. 1.21 and to expedite prosecution of this application, Applicants provisionally elected, with traverse, Group 1. Applicants respectfully contend that Claims 6-21, which cover compositions of the compounds of Formula I and methods of treatment using the compounds of Formula I, should also be examined.

Section 112, First Paragraph

The Examiner has rejected Claims 1-4 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner has alleged that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants respectfully traverse this rejection. Applicants note that Claim 4 is a species claim. Applicants believe that this claim was included in error with respect to this rejection. Applicants wish to point out that the definitions of substituents R, X, R¹, V and R² have been amended in Claims 1-3. Applicants contend that the schemes and experimentals, as well as the knowledge in the art, enables one with ordinary skill to make and use compounds of Claims 1-3. Therefore, Applicants respectfully request that this rejection be withdrawn.

Section 102

The Examiner has rejected Claims 1-3 under 35 U.S.C. 102(b) as allegedly being anticipated by Belanger *et al.*, (US Patent No. 4332810). The Examiner has also rejected Claims 1-3 under 35 U.S.C. 102(b) as allegedly being anticipated by Iddon Brian *et al.*, (Caplus English abstract DN 113:131976).

Applicants respectfully traverse this rejection. As noted in section 2131 of the MPEP, "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).


As mentioned previously, Claims 1-3 have been amended. In Claims 1-2, V is defined as heterocycle or aryl, while in Claim 3, V is defined as phenyl. Applicants note that neither the Belanger nor the Iddon Brian reference discloses compounds with equivalent groups being an aryl or heterocycle. Because the Belanger and Iddon Brian references do not describe each and every element of the claims of the instant invention, Applicants assert that these references do not anticipate Claims 1-3. Therefore, Applicants respectfully request that these rejections be withdrawn.

Double Patenting

The Examiner has provisionally rejected Claims 1-5 as allegedly being unpatentable on the ground of nonstatutory obviousness-type double patenting over Claims 1-5 of copending Application 10/510611. As noted by the Examiner, the claims of 10/510611 have not in fact been patented yet. As this rejection is a provisional rejection, based on a pending application which is still undergoing prosecution and wherein no allowable subject matter has yet been identified, Applicants request that this rejection be held in abeyance.

Applicants respectfully contend that Claims 1-5, as amended, are allowable. An early Notice of Allowance is earnestly solicited. If there are any fees, please charge Deposit Account No. 13-2755. If a telephonic communication will aid in the acceptance of this amendment, please telephone Applicants' representative listed below.

Respectfully submitted,

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